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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|

09/314,889 05/19/99 YU

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| ART UNIT | PAPER NUMBER |
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ULM, J

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DATE MAILED:  
1646

05/04/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/314,889**

Applicant(s)  
**Yu et al.**

Examiner  
**John Ulm**

Group Art Unit  
**1646**



☒ Responsive to communication(s) filed on Apr 4, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-26 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1646

Claims 1 to 26 are pending in the instant application.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 to 21, drawn to an isolated nucleic acid, classified in class 435, subclass 69.1.
- II. Claim 22, drawn to an isolated protein, classified in class 530, subclass 350.
- III. Claim 23, drawn to an antibody, classified in class 530, subclass 388.22.
- IV. Claim 24, in so far as it is drawn to a method of treatment by administering a receptor protein, classified in class 514, subclass 2.
- V. Claim 24, in so far as it is drawn to a method of treatment by administering a compound of unspecified constitution which is an agonist of a receptor protein, classification undeterminable.
- VI. Claims 25 and 26, drawn to a method of treatment by administering a compound of unspecified constitution which is a receptor antagonist, classification undeterminable.

The inventions are distinct, each from the other because:

Inventions I, II and III are compositions containing three structurally and functionally different chemical compounds, each of which can be made and used without the others. Lack of unity is shown by the fact that these three different compounds do not have a common utility which is based upon a common structural feature disclosed as the basis for that common utility.

Art Unit: 1646

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the receptor protein of invention II can be employed to identify ligands thereto in a binding assay which is materially different from the method of treatment that is invention IV.

Inventions I, II and III are unrelated to inventions V and VI. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the methods of treatment which are inventions V and VI do not employ a composition which is encompassed by any of the pending product claims of inventions I to III.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1646

A telephone call was made to Stephen G. Whiteside on 03 May of 2000 to request an oral election to the above restriction requirement, at which time Applicant requested the requirement be sent in writing.


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kuntz can be reached at (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



JOHN ULM  
PRIMARY EXAMINER  
GROUP 1800